

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

APR 26 1999

In re

)
) Decision on
) Petition for Review
) Under 37 C.F.R. § 10.2(c)
)

MEMORANDUM AND ORDER

(hereafter "Petitioner") seeks review of the decision of the Director of the Office of Enrollment and Discipline (hereafter "Director"), dated August 7, 1998, denying his request for a higher score on the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office (hereinafter "examination"), held on August 27, 1997. The petition is denied.

Background

An applicant for registration to practice in patent cases before the Patent and Trademark Office (hereafter "PTO") must achieve a passing score of 70 in both the morning and afternoon sections of the examination. Petitioner took the examination held on August 27, 1997, and received a score of 66 on the morning section.

After receiving his morning section score, Petitioner requested that questions 28 and 29 be regraded, and that his score be raised two points for each question. On August 7, 1998,

the Director denied the request and refused to increase Petitioner's score.

Petitioner now seeks review, under 37 C.F.R. § 10.2(c), by the Commissioner of Patents and Trademarks, of the Director's decision denying credit for Petitioner's answers to questions 28 and 29. Petitioner urges that two points be added to his score for each of these questions, and that he thereby be awarded a passing grade for the morning section of the examination held on August 27, 1998.

Opinion

Petitioner bears the burden of establishing error in the grading of his answers to examination questions 28 and 29. 37 C.F.R. § 10.7(c). All of Petitioner's arguments have been considered and, for the following reasons, no points will be added to his morning section score for the examination held on August 27, 1997.

Question 28

Question 28 reads as follows:

28. Inventor Jones received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also tells you that the original patent with the blue ribbon seal has been lost. Your advice to Jones should include:

- (A) under 35 U.S.C. § 251, new matter cannot be added to a reissue application.
- (B) any added claims to the new embodiment would not satisfy 35 U.S.C. § 112.

- (C) under 35 U.S.C. § 251, it is too late to enlarge the scope of the issued claims in a reissue application.
- (D) under 35 U.S.C. § 251, Jones cannot get a reissue of a patent that has been lost.
- (E) (A) and (B).

The correct answer is (E). More specifically, the question inquires which of four statements should be included in advice to inventor Jones who received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also informs you that the original patent with the blue ribbon has been lost. Choice (A) is a correct statement, because new matter cannot be added to a reissue application. 35 U.S.C. § 251. Choice (B) is also correct, because any added claims to the new embodiment, which according to the fact pattern has not been disclosed, would not satisfy 35 U.S.C. § 112. In particular, the written description requirement of the first paragraph of § 112 would not be satisfied. Choice (C) is not correct, because a broadening reissue can be filed within 2 years of the issued claims, and only 18 months have elapsed. Choice (D) is not correct, because 35 U.S.C. § 251 does not preclude reissuance of a patent because the blue-seal copy has been lost. See 37 C.F.R. § 1.178 (providing that an affidavit attesting to the loss of the patent may be submitted in lieu of the original patent). Accordingly, the best answer is choice (E), which is both (A) and (B).

Petitioner urges that choice (A) is also a good answer because choice (B) is ambiguous. Petitioner argues that additional language must be added to make choice (B) unambiguous. This argument is without merit. While Petitioner's rewording of choice (B),

- (B) Any added claims drawn to the subject matter contained in the new embodiment would not satisfy 35 U.S.C. § 112

is a true statement, the added verbiage neither adds to nor shades the meaning of the original statement.

Petitioner argues further that the following alternative interpretation of choice (B) is justified, and false:

- (B) Any added claims drawn to subject matter disclosed but not claimed in the original disclosure, appended to the new embodiment would not satisfy 35 U.S.C. § 112.

This argument is without merit. Petitioner's interpretation of choice (B) contradicts the facts given in the statement of the question, i.e., that the original patent failed to disclose the new embodiment. Examinees are warned expressly in the Directions on the cover sheet of the examination: "[d]o not assume any additional facts not presented in the question." Petitioner's interpretation ignores this prohibition. Moreover, although on the facts of question 28, claims could be presented to "subject matter disclosed but not claimed in the original disclosure," such claims, if "appended to the new embodiment," (emphasis added) would not satisfy 35 U.S.C. § 112. By hypothesis, the

"new embodiment" is not disclosed in the original patent.

Accordingly, Petitioner's version of choice (B) is also a true statement.

In view of the preceding considerations, Petitioner is not entitled to credit for his answer to question 28.

Question 29

Question 29 reads as follows:

29. You have filed a complete plant patent application claiming 1) a distinct and new plant variety and 2) a method for obtaining the plant variety. Which of the following statements is/are false?

- I. You may not amend the application to add additional description of the plant variety inadvertently omitted from the original application.
- II. You may be required to deposit an adequate sample of the plant variety with an acceptable depository and the claims may be rejected under 35 U.S.C. § 112 without the deposit.
- III. You may be required to restrict the claims between plant variety and plant method inventions you want examined for ultimate issuance as the single claim in the plant patent application to which you are entitled.

- (A) III.
- (B) II and III.
- (C) I and II.
- (D) I and III.
- (E) I, II, and III.

The correct answer is (C), because statements I and II are false, whereas statement III is true. Petitioner agrees that statements I and II are false, but urges that statement III is also false, and therefore (E) is the most correct answer.

Section 161 of the Patent Act states that "[t]he provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided." As explained in MPEP 1608, the sole exception is set forth in 35 U.S.C. § 162. Restriction, pursuant to 35 U.S.C. § 121, is part of the examination process and is not excluded in Section 162. Thus, because the examiner could restrict the claims pursuant to 35 U.S.C. § 121, Statement III is a true statement.

Petitioner urges that statement III is false relative to the fact pattern of question 29, "[y]ou have filed a complete plant patent application" Petitioner urges that restriction is improper in this case because restriction practice is optional under 35 U.S.C. § 121. In particular, Petitioner argues that "in the case of a plant patent application, such a restriction is not permitted to be optional, according to 37 C.F.R. § 1.164." Petitioner urges further that 37 C.F.R. §§ 1.163(c)(10), 1.164 and MPEP § 1605 constitute exceptional provisions under 37 C.F.R. § 1.161 that preclude the application of the other rules of Title 37, Code of Federal Regulations. Accordingly, Petitioner concludes that choice (E) (I, II and III are false) is the correct answer.

Petitioner's arguments are not persuasive. Question 29 asks only whether "you" may be required to restrict the claims. A restriction requirement only requires that the claims be directed towards independent and distinct inventions. These independent

and distinct inventions may, or may not, constitute patentable subject matter. When two claims are restricted, it is impossible to know, prior to examination, whether either claim will be allowed. No provision in 37 C.F.R. § 1.164 mandates the imposition of a restriction requirement, which is discretionary, by statute. Nor do any provisions in Sections 1.163 or 1.164 preclude application of 37 C.F.R. § 1.142, which governs restriction. Accordingly, since Statement III states you "may" be required to restrict the claims, it is a true statement.

In view of the preceding considerations, Petitioner is not entitled to credit for his answer to question 29.

ORDER

Upon consideration of the petition to the Commissioner for a higher score on the morning section of the examination held on August 27, 1997, it is

ORDERED that the petition is denied.

A handwritten signature in dark ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks